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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,955	06/27/2003	Takumi Tanaka	500.42885X00	4848

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EXAMINER	
DAO, THUY CHAN	

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,955	TANAKA ET AL.	
	Examiner	Art Unit	
	Thuy Dao	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/30/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the application filed on June 27, 2003.

2. Claims 1-9 have been examined.

Priority

3. The application claims priority to Foreign Application No. 2002-188938 (JP) filed June 28, 2002.

The priority date considered for this application is June 28, 2002.

Information Disclosure Statement

4. The Office acknowledges receipt of the Information Disclosure Statement filed on October 30, 2003. It has been placed in the application file and the information referred to therein has been considered by the examiner.

Specification

5. The disclosure is objected to because of the following informalities:

Page 6, line 11 should be - -... Program [dall] call division B 121 ...- -; and line 20 should be - -...Program [dall] call division [c] C 131 ...- -.

Appropriate correction is required.

Claim Rejections – 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 7-9 are rejected because the claimed invention is directed to non-statutory subject matter: a program generation program.

These are merely software per se and data structure per se.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

See Annex IV (a) of Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (signed October 26, 2005) - OG Cite: 1300 OG 142. Online version can be retrieved at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>.

Under the principles of compact prosecution, claims 7-9 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example, - -A program generation program, tangibly embodied in a storage medium, comprising the codes for executing the steps of: ...- -.

Claim Rejections – 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication No. 2002/0188434 A1 to Shulman et al. (hereinafter "Shulman").

Claim 1:

Shulman discloses *a program generation method, comprising the steps of:*

inputting a screen file described in a language to display a screen or to control display of a screen (e.g., FIG. 7a-f and related text; page 5, [0037], lines 11-17)*; and*

generating, according to the screen file, a skeleton of an application program to conduct a predetermined job using parameters of which data items are obtained from the screen file, the parameters being used as input data (e.g., FIG. 6, steps 300, 305, 310, page 5, [0038]; step 335, page 7, [0046]).

Claim 2:

The rejection of claim 1 is incorporated. Shulman also discloses:

defining, when editing the screen file, a type or an attribute of data obtained in a form of the screen (e.g., FIG. 7a-f and related text)*;*

specifying a function name to call the application program (e.g., page 5, [0038], lines 32-38; page 7, [0047], lines 11-17)*; and*

specifying a programming language used to code the application program (e.g., FIG. 2, Computing Platforms 60-80, page 2, [0024]; page 6, [0041], lines 9-12).

Claim 3:

The rejection of claim 2 is incorporated. Shulman also discloses:

extracting, when calling the application program, data from a data group of a predetermined format, the data being required to call the application program (e.g., FIG. 4, block 220 Component Library, page 4, [0036])*; and*

converting the data according to a data definition of the programming language used to code the application program (e.g., FIG. 2, converting the data corresponding with Computing Platforms 60-80 based on input from User Stations 110-140).

Claims 4-6:

Claims 4-6 are program generation apparatus versions, which recite the same limitations as those of claims 1-3, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claims, they also teach all of the limitations of claims 4-6.

Claims 7-9:

Claims 7-9 are program tangibly embodied in a storage medium versions, which recite the same limitations as those of claims 1-3, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claims, they also teach all of the limitations of claims 7-9.

10. Claims 1, 4, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7,058,536 to Gabriel (hereinafter "Gabriel").

Claim 1:

Gabriel discloses *a program generation method, comprising the steps of:*

inputting a screen file described in a language to display a screen or to control display of a screen (e.g., FIG. 2, col.3: 61 – col.4: 29)*; and*

generating, according to the screen file, a skeleton of an application program to conduct a predetermined job using parameters of which data items are obtained from the screen file, the parameters being used as input data (e.g., FIG. 1, col.3: 17-19, 61-64; FIG. 3, col.5: 49 – col.6: 36).

Claim 4:

Claim 4 is a program generation apparatus version, which recites the same limitations as those of claim 1, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claim, they also teach all of the limitations of claim 4.

Claim 7:

Claim 7 is a program tangibly embodied in a storage medium version, which recites the same limitations as those of claim 1, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claim, they also teach all of the limitations of claim 7.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure:

US Patent Publication No. 2004/0205706 A1 discloses a program generation method (FIG. 2, a flow diagram for automatically generating a Default Project) comprising the steps of inputting a screen file (FIGs. 3-6) and generating a skeleton of an application program using parameters obtained from the screen file (FIGs. 8-9).

12. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone is (571) 272 8570. The examiner can normally be reached on Monday – Friday from 6:30AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. Dao

ANTONY NGUYEN-BA
PRIMARY EXAMINER